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No. 86-215

IN THE

Supreme Court of the United States

OCTOBER TERM, 1986

J. A. LAPORTE, INC.,

Petitioner,

v.

NORFOLK DREDGING CO.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

This Petition was based on *de novo* fact finding by the Court of Appeals for the Federal Circuit, namely the new finding that the *seller* (Jantzen) solicited the sale. The Respondent's Brief states the Federal Circuit relied only on the facts found by the District Court, namely that the *buyer* (LaPorte) solicited the sale. There are two problems with Respondent, Norfolk Dredging's, position; those facts do not violate the statute, and the Federal Circuit took pains to avoid saying they did.

LaPorte placed the order to have the cone built by Jantzen and by Ackerman. The Respondent's Brief

assumes without citation this is a violation of the "on sale" clause, 35 U.S.C. § 102(a). However, it is not. No court has ever so held, and no lower court could so hold without distinguishing *Pennock v. Dialogue*, 27 U.S. (2 Peters) 1 (1829), which held that having an invention built by employees did not violate the then-statute's proscription.

The original opinion of the Federal Circuit could be so read when it cryptically equated buyer-solicited sales with seller-solicited sales (p. 6a). When this was pointed out to the Federal Circuit (pp. 30a-33a), the Court "clarified" the opinion (p. 12a). It did not say it was making new law. Rather, it adverted to an unspecified "critical finding" and distinguished the LaPorte-Ackerman buyer solicited sale from the LaPorte-Jantzen sale. The only available ground of distinction was a finding that Jantzen, the seller, solicited that sale.

Norfolk Dredging nine times urged on the Federal Circuit that Jantzen solicited the sale (p. 29a). Norfolk Dredging now admits that the District Court found only that LaPorte, the buyer, solicited the sale. It now urges the "critical finding" (p. 8a) is the uncontested fact that LaPorte, the buyer, ordered the cone (solicited the sale) (p. 15a).

This position now urged by Respondent, Norfolk Dredging, requires only two assumptions. First, Norfolk Dredging assumes that the clarification which distinguished the LaPorte-Ackerman transaction from the LaPorte-Jantzen transaction, in truth equated them. Norfolk Dredging assumes the Federal Circuit said both transactions were buyer solicited. Second, Norfolk Dredging assumes the Federal Circuit made new law, importantly restricting the rights of inven-

tors, and distinguishing precedent of this court, without saying so, and indeed while disclaiming it was doing so. Neither assumption can be seriously entertained.

The Respondent's Brief itself points out a more likely explanation of the Federal Circuit's opinion. It states (p. 5) that the Federal Circuit "would have been justified in surmising" that the District Court made the "holding" (finding) that Jantzen, the seller, solicited the sale. Indeed the Court would have been justified. It was nine times urged that was the fact and it therefore would have been justified in surmising the District Court had so found. That a Court was induced into error does not insulate the error.

CONCLUSION

The Respondent's Brief only reinforces that the judgment below was based on *de novo* fact finding, urged on the Court below by the Respondent itself and defended by the Respondent here as justified. The Petition should be granted and the judgment summarily reversed.

Respectfully submitted,

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